

Application No. 09/737,687

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Allen, et al.

Application No.: 09/737,687

Filed: 12/14/2000

Title: SALICYLAMIDES AS SERINE PROTEASE  
INHIBITORS

Attorney Docket No.: 218

Group Art Unit:  
1626

Examiner:  
WRIGHT, S.

Assistant Commissioner for Patents  
Washington, D.C. 20231

Notice of Appeal

Dear Sir,

In the above-named Application, a restriction requirement was made final by the Examiner in an Office Action dated November 20, 2002. A Response has been filed, as well as a Petition from Requirement for Restriction under 37 C.F.R. § 1.144. Applicants now give Notice of Appeal, pending resolution of the § 1.144 Petition.

Jurisdiction.

While the Examiner did not reject the claims after examination on the merits, the Examiner's objection to the Claims 1-8 and 10-17 as containing non-elected subject matter is appealable to the Board as established in *In re Haas*, 486 F.2d 1053 (1973) (*Haas I*). *Haas I* was an appeal from a dismissal by the Board for lack of subject matter jurisdiction over an appeal from an examiner's objection to claims. The examiner in *Haas I*, relying on 35 U.S.C. 121, objected to two Markush claims as each being drawn to multiple patentably distinct inventions and withdrew them both from further consideration. A species claim was allowed and a "narrow Markush claim, encompassing only those reactive moieties similar to the allowed species, was suggested" (*Haas I* at 1054). The applicants were then compelled to cancel the original claims.

These facts are very similar to those in this Application. Here, the Examiner required the Applicants to elect a single disclosed species from within a group of Markush claims and the non-elected species were required to be withdrawn permanently from further consideration. The Applicants elected a single species for examination purposes with traverse but did not cancel the non-elected species from the claims. Each claim of Claims 1-8 and 10-17 subsequently was objected to as containing non-elected subject matter *within* each claim and not *between* claims.

In general, the Board's jurisdiction to review an action by the examiner is "restricted to those adverse decisions of examiners 'which relate, at least indirectly, to matters involving the rejection of claims'" [*Id.* at 1055, citing *In re Hengehold*, 440 F.2d 1395 (1971)]. However, the *Haas* court went on to hold that an objection can deny the applicant substantive rights and amount to a rejection. To determine whether a rejection has in fact occurred, the court "look[s] both to the language employed [by the examiner] and the effect thereof. We consider the form and the substance...The particular packaging [of the restriction requirement] employed cannot be determinative" (*In re Haas* at 1055). In *Haas I*, as well as in this application, the requirement to withdraw non-elected species from within a single claim was made permanent. The court held,

The absolute "withdrawal" herein cannot properly be categorized as merely a "requirement" or "objection" and the avenue of review thereby be restricted to petition and judicial examination under 5 USC § 701-6. An examiner's adverse action of this nature is a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board.

*Id.* at 1056. This amounted to a rejection as each claim, in its entirety, would never be examined on the merits, essentially denying the patentability of the Applicants' invention as they see fit to claim it. As this amounted to a rejection of the Claims, the Applicants are entitled to appeal the decision of the Examiner.

#### Ripeness.

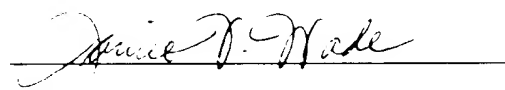
In Office Actions dated December 5, 2001 and November 20, 2002, Claims 1-8 and 10-17 were twice objected to by the Examiner as containing non-elected species, with the Action being made final on November 20, 2002. For the reasons stated above, the refusal to examine the Claims on the merits amounts to a rejection of Applicants'

Claims. Pending resolution of the Petition from Requirement for Restriction, the restriction requirement is now eligible for appeal under 35 U.S.C. § 134.

The Applicants, therefore, give notice for appeal of the objection to Claims 1-8 and 10-17 as containing non-elected subject matter, pending resolution of Applicants' Petition from Requirement for Restriction under 37 C.F.R. § 1.144.

Respectfully submitted,

Date: 3-19-03



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